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TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket: 00399-12

Applicant: Timothy L. Macdonald, et al.

Invention: Felbamate Derived Compounds

Serial No: 09/925,224

Filed: August 9, 2001

Art Unit: 1624

Examiner: Sudhaker Patel

Certificate Under 37 CFR 1.8(a)

I hereby certify that this correspondence, and all papers referred to herein, is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231

on September 25, 2002

Sue Ann Carr

**Terminal Disclaimer Under 37 CFR § 1.321  
and Statement Under 37 CFR § 3.73(b)**

Box AF  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

The captioned application is owned by the University of Virginia Patent Foundation by virtue of an assignment from the inventors to the University of Virginia (copy enclosed) and an assignment from the University of Virginia to the University of Virginia Patent Foundation (copy enclosed). This application is a continuation of International Patent Application No: PCT/US00/03147, filed on February 8, 2000 and claims priority under 35 U.S.C. §119(e) to US Provisional Patent Application No. 60/119,254, 60/136,881 and 60/137,204, filed on February 9, 1999, June 1, 1999 and June 2, 1999, respectively.

The University of Virginia Patent Foundation is also the owner of co-pending US Application Serial Nos. 09/913,075 (filed as a national stage application of PCT/US00/03147) and 10/023,059 (filed as a continuation of International Patent Application No:

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PCT/US00/03147) by virtue of the enclosed assignment documents. The undersigned attorney has reviewed the documents evidencing title as represented above and certifies to the best of his knowledge and belief that title is as represented.

The University of Virginia Patent Foundation hereby disclaims the terminal part of any patent granted on application no. 09/925,224 that would extend beyond the expiration date of the full statutory term, as defined in 35 U.S.C. §154 to 156 and as presently shortened by any terminal disclaimer, of any patent that issues from U.S. Application Serial No. 09/913,075 or 10/023,059.

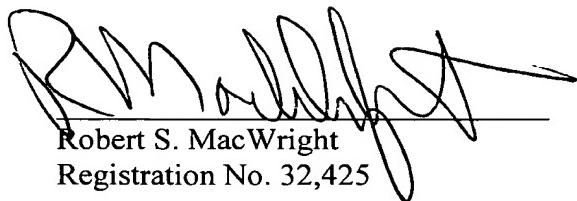
The University of Virginia Patent Foundation hereby acknowledges that any patent so granted on the above-identified application shall be enforceable only for and during such period that legal title to said patent shall be the same as legal title to U.S. Application Serial No. 09/913,075 or 10/023,059. The undersigned on behalf of the owner further agrees that this agreement is to run with any patent granted on the captioned application and is to be binding upon the grantee, its successors, and assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the captioned application that would extend past the expiration date of a patent issuing from either U.S. Application Serial No. 09/913,075 or 10/023,059, in the event that the patent issuing from either U.S. Application Serial No. 09/913,075 or 10/023,059 expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

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The undersigned is authorized to act on behalf of the University of Virginia Patent Foundation as evidenced by his title appearing below.

Date: 9/24/02



Robert S. MacWright  
Registration No. 32,425

Title: CEO and Executive Director  
University of Virginia Patent Foundation  
1224 West Main Street, Suite 1-110  
Charlottesville, VA 22903  
(434) 924-2175

## ASSIGNMENT

WHEREAS, the **University of Virginia**, 314 Madison Hall, P.O. Box 400301, Charlottesville, Virginia 22904-4301 (the "Assignor") possesses the right, title and interest for and in an invention entitled

### **FELBAMATE DERIVED COMPOUNDS**

described in U.S. Utility Patent Application Serial No. 09/925,224 , filed August 9, 2001; and

WHEREAS, the **University of Virginia Patent Foundation**, a non-profit organization having a place of business at 1224 West Main Street, Suite 1-110, Charlottesville, Virginia 22903 (the "Assignee") is desirous of acquiring the entire right, title and interest in and to the aforesaid invention, including any tangible materials embodied in or encompassed by the invention and any trade secrets pertaining to the invention, and any improvements thereon, (the "Invention") and in and to said applications for Letters Patent thereon in the United States, its territories and possessions ("United States") and all foreign countries, including rights to claim priority, to any provisional applications, and in and to any Letters Patent of the United States or any foreign country which may be granted therefor, including any and all reissues, divisions, continuations, continuations-in-part, renewals, substitutes or extensions thereof (the "Rights");

NOW, THEREFORE, for and in consideration of the sum of One Dollar (\$1.00) and other good and valuable consideration, the receipt of which is hereby acknowledged, Assignor has sold, assigned, transferred and conveyed, and does hereby sell, assign, transfer and convey to Assignee, its successors and assigns, the entire right, title and interest in and to the aforesaid Invention and Rights, except that Assignee hereby grants back to the Assignor a royalty free non-transferable license to make and use the Invention under the Rights for educational and research purposes, only. The aforesaid assignment includes the right in and to all income, royalties, damages and payments now or hereafter due or payable with respect to any Letters Patent which may be granted, and in and to all causes of action (either in law or in equity), and the right to sue, counterclaim, and recover for past, present and future infringement of the rights assigned or to be assigned under this Assignment, as fully and entirely as the same would have been held and enjoyed by Assignor if this sale and assignment had not been made;

AND Assignor hereby authorizes and requests the appropriate governmental officials to issue any and all such United States or foreign Letters Patent under said invention, or resulting from any of said applications thereof, to the Assignee, as the assignee of the entire right, title and interest in and to the same;

AND Assignor hereby represents, warrants and covenants that it has the full right to convey the entire interest herein assigned, that it has not executed and will not execute any instrument or assignment in conflict herewith, and that the rights assigned herein are not otherwise encumbered by any grant, license or right;

AND Assignor further covenants and agrees that Assignors will at any time upon request make, execute and deliver without further compensation, any and all other instruments in writing, including further applications, papers, affidavits, power of attorney, assignments, and other documents, and do all lawful acts and things, which, in the opinion of counsel for said Assignee, its successors and assigns, may in any country be required or necessary more effectively to secure to and vest in said Assignee, its successors and assigns the entire right, title and interest in and to said Invention and Rights hereby sold, assigned, transferred and conveyed, and that Assignor will sign any applications for reissue, division, continuation, continuation-in-part, renewal, substitute or extension of said application for Letters Patent or any resulting Letters Patent;

AND Assignor further covenants and agrees that Assignor will at any time upon request communicate to the Assignee, its successors, assigns or other legal representatives any facts relating to the aforesaid invention known to it, and will testify as to the same in any interference, litigation, mediation, arbitration or other proceeding when requested to do so.

IN WITNESS WHEREOF, said Assignor has hereunto set its hand and seal.

Signature of  
Representative for Assignor:

  
\_\_\_\_\_  
David J. Hudson

Representative's Title:

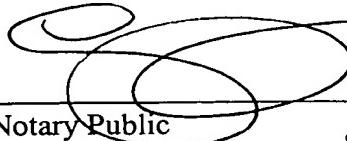
Associate Vice President for Research  
and Public Service, University of Virginia

Place of Execution:

Charlottesville, Virginia

COUNTY OF ALBEMARLE )  
                              ) ss:  
COMMONWEALTH OF VIRGINIA )

On this 23 day of January, 2002, before me, a Notary Public in and for the County of Albemarle in the Commonwealth of Virginia, personally appeared David J. Hudson, to me known as the individual of that name, who executed the foregoing instrument and acknowledged the same to be of his own free will for the purposes therein set forth.

  
\_\_\_\_\_  
Notary Public  
My commission expires: 7-31-03

## ASSIGNMENT

WHEREAS, we **Timothy L. Macdonald, Thomas A. Miller, Charles D. Thompson and Christine M. Dieckhaus** (the "Assignors"), have been named inventors in an invention entitled

### FELBAMATE DERIVED COMPOUNDS

described in U.S. Utility Patent Application Serial No. 09/925,224 , filed August 9, 2001; and

WHEREAS, the **University of Virginia**, 314 Madison Hall, P.O. Box 400301, Charlottesville, Virginia 22904-4301 (the "Assignee"), is desirous of acquiring the entire right, title and interest in and to the aforesaid invention, including any tangible materials embodied in or encompassed by the invention and any trade secrets pertaining to the invention, and any improvements thereon, (the "Invention") and in and to said applications for Letters Patent thereon in the United States, its territories and possessions ("United States") and all foreign countries, including rights to claim priority, to any provisional applications, and in and to any Letters Patent of the United States or any foreign country which may be granted therefor, including any and all reissues, divisions, continuations, continuations-in-part, renewals, substitutes or extensions thereof (the "Rights");

NOW, THEREFORE, for and in consideration of the sum of One Dollar (\$1.00) and other good and valuable consideration, the receipt of which is hereby acknowledged, Assignors have sold, assigned, transferred and conveyed, and does hereby sell, assign, transfer and convey to Assignee, its successors and assigns, the entire right, title and interest in and to the aforesaid Invention and Rights, except that Assignee hereby grants back to the Assignors a royalty free non-transferrable license to make and use the Invention under the Rights for educational and research purposes, only. The aforesaid assignment includes the right in and to all income, royalties, damages and payments now or hereafter due or payable with respect to any Letters Patent which may be granted, and in and to all causes of action (either in law or in equity), and the right to sue, counterclaim, and recover for past, present and future infringement of the rights assigned or to be assigned under this Assignment, as fully and entirely as the same would have been held and enjoyed by Assignors if this sale and assignment had not been made;

AND Assignors hereby authorize and request the appropriate governmental officials to issue any and all such United States or foreign Letters Patent under said invention, or resulting from any of said applications thereof, to the Assignee, as the assignee of the entire right, title and interest in and to the same;

AND Assignors hereby represent, warrant and covenant that they have the full right to convey the entire interest herein assigned, that they have not executed and will not execute

AND Assignors further covenant and agree that Assignors will at any time upon request make, execute and deliver without further compensation, any and all other instruments in writing, including further applications, papers, affidavits, power of attorney, assignments, and other documents, and do all lawful acts and things, which, in the opinion of counsel for said Assignee, its successors and assigns, may in any country be required or necessary more effectively to secure to and vest in said Assignee, its successors and assigns the entire right, title and interest in and to said Invention and Rights hereby sold, assigned, transferred and conveyed, and that Assignors will sign any applications for reissue, division, continuation, continuation-in-part, renewal, substitute or extension of said application for Letters Patent or any resulting Letters Patent;

AND Assignors further covenant and agree that Assignors will at any time upon request communicate to the Assignee, its successors, assigns or other legal representatives any facts relating to the aforesaid invention known to it, and will testify as to the same in any interference, litigation, mediation, arbitration or other proceeding when requested to do so.

IN WITNESS WHEREOF, Assignors have hereunto set their hands and seals.

Signature of Inventor / Date of Execution:

Inventor's Name:

Inventor's Resident Address:

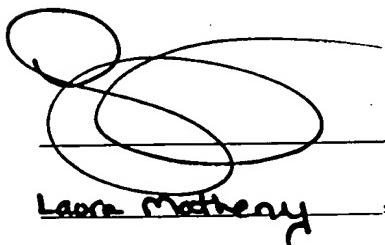
Timothy L. Macdonald  
Timothy L. Macdonald  
2625 Jefferson Park Avenue  
Charlottesville, VA 22903

Place of Execution:

City of Charlottesville, Virginia

COUNTY / CITY OF )  
Albemarle ) ss:  
COMMONWEALTH OF VIRGINIA )

On this 31 day of August, 2001, before me, a Notary Public in and for the County/City aforesaid in the Commonwealth of Virginia, personally appeared Timothy L. Macdonald, to me known as the individual of that name, who executed the foregoing instrument and acknowledged the same to be of his own free will for the purposes therein set forth.



[signature, please print name below]

Laura Matney, Notary Public, my commission expires on: 07-31-01

Signature of Inventor / Date of Execution:

Inventor's Name:

Inventor's Resident Address:

Thomas A. Miller 20 Aug 01

Thomas A. Miller  
3000 Broadway, Hayermeyer hall  
New York, NY 10027

Place of Execution:

COUNTY / CITY OF \_\_\_\_\_ )  
\_\_\_\_\_  
\_\_\_\_\_  
) ss:

STATE OF \_\_\_\_\_ )  
\_\_\_\_\_  
)

Edna Velez  
EDNA VELEZ  
Notary Public, State of New York  
No. 60-4988550  
Qualified in Westchester County  
Commission Expires 11/12/01

On this 20<sup>th</sup> day of August, 2001, before me, a Notary Public in and for the County/City and State aforesaid, personally appeared Thomas A. Miller, to me known as the individual of that name, who executed the foregoing instrument and acknowledged the same to be of his own free will for the purposes therein set forth.

Edna Velez

[signature, please print name below]

Edna Velez, Notary Public, my commission expires on: 11/12/01

Signature of Inventor / Date of Execution:

Inventor's Name:

Inventor's Resident Address:

Charles D. Thompson

40 Dartmouth Street  
Watertown, MA 02472

Place of Execution:

COUNTY / CITY OF \_\_\_\_\_ )  
\_\_\_\_\_  
\_\_\_\_\_  
) ss:

STATE OF \_\_\_\_\_ )  
\_\_\_\_\_  
)

On this \_\_\_\_\_ day of \_\_\_\_\_, 2001, before me, a Notary Public in and for the County/City and State aforesaid, personally appeared Charles D. Thompson, to me known as the individual of that name, who executed the foregoing instrument and acknowledged the same to be of his own free will for the purposes therein set forth.

\_\_\_\_\_ [signature, please print name below]

\_\_\_\_\_, Notary Public, my commission expires on: \_\_\_\_\_

Signature of Inventor / Date of Execution:

Inventor's Name:

Inventor's Resident Address:

Thomas A. Miller

3000 Broadway, Hayermeyer hall  
New York, NY 10027

Place of Execution:

COUNTY / CITY OF \_\_\_\_\_ )  
\_\_\_\_\_  
STATE OF \_\_\_\_\_ ) ss:  
\_\_\_\_\_  
)

On this \_\_\_\_ day of \_\_\_\_\_, 2001, before me, a Notary Public in and for the County/City and State aforesaid, personally appeared Thomas A. Miller, to me known as the individual of that name, who executed the foregoing instrument and acknowledged the same to be of his own free will for the purposes therein set forth.

[signature, please print name below]

\_\_\_\_\_, Notary Public, my commission expires on: \_\_\_\_\_

Charles D. Thompson 9/24/01

Signature of Inventor / Date of Execution:

Inventor's Name:

Inventor's Resident Address:

Charles D. Thompson  
22 Partridge Lane  
Stow, MA 01775

Place of Execution:

COUNTY / CITY OF \_\_\_\_\_ )  
Norfolk \_\_\_\_\_ ) ss:  
STATE OF Massachusetts \_\_\_\_\_ )

On this 24 day of Sept., 2001, before me, a Notary Public in and for the County/City and State aforesaid, personally appeared Charles D. Thompson, to me known as the individual of that name, who executed the foregoing instrument and acknowledged the same to be of his own free will for the purposes therein set forth.

Laura M. Beckford

[signature, please print name below]

\_\_\_\_\_, Notary Public, my commission expires on: March 31, 2026

Signature of Inventor / Date of Execution:

Inventor's Name:

Inventor's Resident Address:

*Christine M. Dieckhaus* 2 Jan 2002  
Christine M. Dieckhaus  
113 Hampton Green Drive  
North Wales, PA 19454

Place of Execution:

Accent Notary 420 N Broad St Lansdale, PA 19446

COUNTY / CITY OF Montgomery )  
   ) ss:  
STATE OF Pennsylvania         )

On this 2nd day of January, 2004, before me, a Notary Public in and for the County/City and State aforesaid, personally appeared Christine Dieckhaus, to me known as the individual of that name, who executed the foregoing instrument and acknowledged the same to be of her own free will for the purposes therein set forth.

Carole L Maiorillo [signature, please print name below]  
Carole L Maiorillo, Notary Public, my commission expires on: June 6, 2005

